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EXAMINER

CHOI, PETER H

ART UNIT	PAPER NUMBER
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3623

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DETAILED ACTION

35 USC 112, 1st paragraph rejection

1. Applicant argues that Table 2 and paragraphs 29-44 of the specification provide enablement for one of ordinary skill in the art to understand how to use the claimed invention to select at least between the three examples provided in Table 2.

The Examiner respectfully disagrees. As per MPEP 2164.01a, the Wands Factors considered when determining whether there is sufficient evidence to support a determination that a disclosure does not satisfy the enablement requirement and whether any necessary experimentation is "undue" include, but are not limited to:

- (A) the breadth of the claims;
- (B) the nature of the invention;
- (C) the state of the prior art;
- (D) the level of one of ordinary skill;
- (E) the level of predictability in the art;
- (F) the amount of direction provided by the inventor;
- (G) the existence of working examples; and

(H) the quantity of experimentation needed to make or use the invention based on the content of the disclosure

The portions cited by the Applicant do not discuss anything further than “exposure number” and “exposure duration”, a combination thereof. The examples provided in the specification in table 2 relate solely to “exposure number” and “exposure duration”; thus, there are no additional considerations, and the exposure cost measure is entirely based upon, and not “in part”, exposure amount and duration. The specification does not provide adequate direction or guidance, or any examples that would have enabled one of ordinary skill in the art to practice the claimed invention without undue experimentation. As any of a plurality of other factors known to one of ordinary skill in the art may have been considered in calculating an exposure cost measure, the resulting level of experimentation based on the scope of the claims is unduly extensive. Thus, in consideration of the Wands factors, it is concluded that “undue experimentation” would have been needed to make and use the claimed invention.

35 USC 112, 2nd paragraph rejection

2. Applicant argues that Table 2 and paragraphs 29-44 provide guidance sufficient to choose between three exemplary exposure cost measures, and that claims 1-15 are not indefinite.

The Examiner respectfully disagrees. As noted above, the portions cited by the Applicant do not discuss anything further than “exposure number” and “exposure duration”, a combination thereof. The examples provided in the specification in table 2 relate solely to “exposure number” and “exposure duration”; thus, there are no additional considerations, and the exposure cost measure is entirely based upon, and not “in part”, exposure amount and duration. As further noted in the previous rejection, it is unclear how considerations other than exposure amount and duration would be combined to yield a single exposure cost measure; thus the limitation is indefinite.

Prior Art Rejections

3. Applicant has requested clarification regarding the references relied upon in the rejection of claims 1-15.

As noted in the previous rejection mailed June 5, 2009, claims 1-15 are rejected under 35 USC 103(a) as being unpatentable over **Chan et al.** (US Patent #6,889,375), in view of "Secure Workflow Model" by Hung Chak Kuen Patrick, a thesis submitted to the Hong Kong University of Science and Technology in April 2001 (referred to as **Patrick**) and further in view of Michael zur Muehlen's "Workflow-Based Process Controlling – Or: What You Can Measure You Can Control" (referred to as **Muehlen**). The Examiner notes that Patrick is the surname of the author of the "Secure Workflow Model" reference.

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4. Regarding Muehlen, Applicants argues that there is no indication of a specification for a system or method but merely another research paper that comes to the conclusion that "active feedback of evaluation data on the modeling of workflow processes is a promising candidate for further research". Applicant further argues that non-patent literature is not examined and therefore not entitled to a presumption of enablement.

The Examiner respectfully disagrees. MPEP 904 states that "The examiner, after having obtained a thorough understanding of the invention disclosed and claimed in the nonprovisional application, then searches the prior art as disclosed in patents **and other published documents, i.e., nonpatent literature (NPL)**. Any document used in the rejection of a claim is called a reference." (emphasis added).

Further, as per MPEP 706.02 and 35 USC 102(a) and (b),

A person shall be entitled to a patent unless -

(a) the invention was known or used by others in this country, or patented **or described in a printed publication in this or a foreign country**, before the invention thereof by the applicant for patent, or

(b) the invention was patented **or described in a printed publication in this or a foreign country** or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States, (emphasis added).

The Examiner notes that under 35 USC 103(a), which is the basis of the current rejection of the claims, "[a] patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102.. if the differences between

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the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.” Thus, as Patrick and Muehlen qualify as prior art under 35 USC 102, they are qualify under 35 USC 103(a).

Further regarding the eligibility of nonpatent literature, as per MPEP 2128, “A reference is proven to be a "printed publication" "upon a satisfactory showing that such document has been disseminated or otherwise made available to the extent that persons interested and ordinarily skilled in the subject matter or art, exercising reasonable diligence, can locate it." *In re Wyer*, 655 F.2d 221, 210 USPQ 790 (CCPA 1981)”.

An electronic publication, including an on-line database or Internet publication, is considered to be a "printed publication" within the meaning of 35 U.S.C. 102(a) and (b) provided the publication was accessible to persons concerned with the art to which the document relates. See *In re Wyer*, 655 F.2d 221, 227, 210 USPQ 790, 795 (CCPA 1981).

An electronic publication, like any publication, may be relied upon for all that it would have reasonably suggested to one having ordinary skill in the art. See MPEP § 2121.01 and § 2123

As per MPEP 2121, (I) "When the reference relied on expressly anticipates or makes obvious all of the elements of the claimed invention, **the reference is presumed to be operable**. Once such a reference is found, the burden is on applicant to provide facts rebutting the presumption of operability. *In re Sasse*, 629 F.2d 675, 207 USPQ 107 (CCPA 1980). See also MPEP § 716.07" and (II) The level of disclosure required within a reference to make it an "enabling disclosure" is the same no matter what type of prior art is at issue. **It does not matter whether the prior art reference is a U.S. patent, foreign patent, a printed publication or other** and (III) **A prior art reference provides an enabling disclosure and thus anticipates a claimed invention if the reference describes the claimed invention in sufficient detail to enable a person of ordinary skill in the art to carry out the claimed invention**; "proof of efficacy is not required for a prior art reference to be enabling for purposes of anticipation." *Impax Labs. Inc. v. Aventis Pharm.Inc.*, 468 F.3d 1366, 1383, 81 USPQ2d 1001, 1013 (Fed. Cir. 2006)." (emphasis added).

5. Applicant has incorporated by reference the arguments of March 4, 2009.

In response, the Examiner incorporates by reference the response to said arguments presented June 5, 2009.

6. Applicant argues that Muehlen's asserted computation of "[p]rocess cycle times, lay- and idle times" fails to address the feature of "[c]alculating an exposure cost measure for each of the possible workflows in the set of possible workflows, said exposure cost measure being based upon, in part, details of critical information that is temporarily stored between processing steps within each of said possible workflows".

The Examiner respectfully disagrees. Muehlen teaches the step of measuring the "cost" of a workflow using quantifiable metrics based on the efficiency of processes within said workflow. The lay- and idle-times computed by Muehlen measure the duration of time during the process that the activities of a workflow are not being used, i.e., it is being temporarily stored between processing steps. Thus, the Examiner asserts that Muhlen creates a measure of a workflow based upon the length of time that critical information is temporarily stored between processing steps, thereby meeting the limitation of the claim.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PETER CHOI whose telephone number is (571)272-6971. The examiner can normally be reached on M-F 9-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beth Boswell can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

August 20, 2009

/P. C./
Examiner, Art Unit 3623

/Jonathan G. Sterrett/
Primary Examiner, Art Unit 3623